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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,462	09/08/1999	RICHARD C. GROSSWEILER III	D/99341Q2	8641

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EXAMINER

CLINTON, GREGORY L

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 05/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/391,462

Applicant(s)

GOSSWEILER ET AL. *W*

Examiner

Gregory L. Clinton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Claims 1 – 9 are pending.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 9 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,340,931. Although the conflicting claims are not identical, they are not patentably distinct from each other because both methods comprise substantially the same steps. The difference between this application and the 931 patent is the association with a network accessible document and the printing of said network accessible document within a determined duration present in claim 1 of the 931 patent. Although the method of this application is directed toward navigation and not printing (as the 931 patent's method is), it would have been obvious to modify the method of the 931 patent to provide navigational actions because both printing and navigation (such as displaying a text document or navigating to a particular point in a document) are digital services which may be

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offered through electronic tags (see Harrison et al., U.S. Patent No. 6,249,226, col. 9, lines 28 – 33.)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, and 4 – 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Want et al., U.S. Patent No. 6,342,830 in view of Pulley et al., U.S. Patent No. 6,222,557.

6. As to claim 1, Want et al. teach a system for digital services comprising an electronic tag having a digitally readable identifier (col. 1, lines 66 – 67), an electronic tag reader configured to read the identifier of the electronic tag (col. 1, line 67 – col. 2, line 1), and a computing system connected to the electronic tag reader to provide digital services (col. 2, lines 2 – 5.) However, Want et al. does not teach that the system may be used to navigate N-space data sets.

7. Pulley et al. teach a method for navigating a three-dimensional data set (col. 2, line 66 – col. 3, line 3), with the computing system generating at least one transitional point in N-space for output between a currently displayed start point and a target point referenced by the user (col. 1, line 64 – col. 2, line 2.)

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8. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Pulley et al. with Want et al. because Pulley et al.'s navigation of three-dimensional data sets would enable the method of Want et al. to provide an intuitive and flexible method for navigating an N-space data set (Want et al., col. 1, lines 59 – 64.)

9. As to claim 2, Pulley et al. teaches that the data set is a graphical data set (col. 3, lines 4 – 13.)

10. As to claim 4, the combination of Want et al. and Pulley et al. teach the invention substantially as claimed with respect to claim 1. However, the combination of Want et al. and Pulley et al. does not teach that the electronic tag is premarked.

11. Want et al. teaches that tags may be placed on objects such as a sheet or a card (col. 2, lines 11 – 12.) Official notice is taken of the fact that cards, such as credit cards, are premarked. Credit cards, for example, have the owner's name and card number stamped on them.

12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Want et al. in view of Pulley et al. to make Want et al.'s generic card a credit card premarked with the owner's name and card number because

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premarking the tags would allow a user to easily identify the meaning or purpose of a tag without needing to use the tag reader.

13. As to claim 5, the combination of Want et al. and Pulley et al. teach the invention substantially as claimed with respect to claim 1. However, the combination of Want et al. and Pulley et al. does not teach that the electronic tag presents a surface for user defined annotation.

14. Want et al. teaches that tags may be placed on objects such as a sheet or a card (col. 2, lines 11 – 12.) Official notice is taken of the fact that cards, such as credit cards, may present surfaces for user defined annotation. Credit cards, for example, provide a surface where the card holder may sign the card.

15. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Want et al. in view of Pulley et al. to make Want et al.'s generic card a credit card with a surface for the card holder's signature because providing a surface for user annotation would enable a user to mark the tag with any information the user may find useful.

16. As to claim 6, Want et al. teaches that the electronic tag is read by the tag reader through a wireless connection (col. 7, lines 38 – 41.)

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17. As to claim 7, Want et al. teaches that the wireless connection operates at radio frequencies (col. 7, lines 38 – 41.)

18. As to claim 8, Want et al. teaches that the wireless connection is infrared (col. 7, line 45.)

19. As to claim 9, Want teaches a method comprising the steps of first reading a first electronic tag having a digitally readable identifier with an electronic tag reader, with the digital identifier triggering a default action (Figures 6 and 7, also col. 14, line 62 – col. 15, line 19); and second reading a second electronic tag having a digitally readable identifier with an electronic tag reader, with the digital identifier triggering a second default action (Figures 6 and 7, also col. 15, lines 19 – 35.) However, Want et al. does not teach that either default action is a navigational action.

20. Pulley et al. teaches that the action may be a navigational action (col. 6, lines 12 – 14.)

21. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Pulley et al. with Want et al. for the reasons given above in paragraph 8.

22. Claims 1 and 3 – 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beigel et al., U.S. Patent No. 6,249,212, in view of Card et al., U.S. Patent No. 5,847,709.

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23. As to claim 1, Beigel et al. teaches a system comprising an electronic tag having a digitally readable identifier and an electronic tag reader configured to read the identifier of the electronic tag (col. 2, lines 53 – 58.) However, Beigel et al. does not teach a computing system connected to the tag reader.

24. Card et al. teaches a computing system providing digital navigation services of N-space data (col. 3, lines 2 – 5) with the computing system generating at least one transitional data point in N-space for output between a currently displayed start point and a target point referenced by the identifier (col. 9, lines 37 – 40.)

25. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Card et al. with Beigel et al. because Card et al.'s digital navigation services would enable a user of Beigel et al.'s system to easily interact with and navigate through large N-space data sets (Card et al., col. 2, lines 66 – 67.)

26. As to claim 3, Card et al. teaches that the data set is a document data set (col. 2, lines 66 – 67.)

27. As to claim 4, the combination of Beigel et al. and Card et al. teach the invention substantially as claimed with respect to claim 1. However, the combination of Beigel et al. and Card et al. does not teach that the electronic tag is premarked.

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28. Beigel et al. teaches that tags may be placed on objects (col. 1, lines 5 – 10.) Official notice is hereby taken of the fact that cards, such as credit cards, are premarked. Credit cards, for example, have the owner's name and card number stamped on them.

29. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Beigel et al. in view of Card et al. to make Beigel et al.'s generic object a credit card premarked with the owner's name and card number because premarking the tags would allow a user to easily identify the meaning or purpose of a tag without needing to use the tag reader.

30. As to claim 5, the combination of Beigel et al. and Card et al. teach the invention substantially as claimed with respect to claim 1. However, the combination of Beigel et al. and Card et al. does not teach that the electronic tag presents a surface for user defined annotation.

31. Beigel et al. teaches that tags may be placed on objects (col. 1, lines 5 – 10.) Official notice is hereby taken of the fact that cards, such as credit cards, may present surfaces for user defined annotation. Credit cards, for example, provide a surface where the card holder may sign the card.

32. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Beigel et al. in view of Card et al. to make Beigel et al.'s generic object a credit card with a surface for the card holder's signature because providing a

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surface for user annotation would enable a user to mark the tag with any information the user may find useful.

33. As to claim 6, Beigel et al. teaches that the tag is read by the tag reader through a wireless connection (col. 6, lines 1 – 8.)

34. As to claim 7, Beigel et al. teaches that the wireless connection operates at radio frequencies (col. 6, lines 1 – 8.)

35. As to claim 8, Beigel et al. teaches that the wireless connection is infrared (col. 1, lines 5 – 8.)

Response to Arguments

36. Applicant's arguments filed May 5, 2002, have been fully considered but they are not persuasive. The applicants are arguing in substance the following: (a) the first identification number of the '931 patent is not the same as the digitally readable identifier of claim 9; (b) Neither Want, Pulley, or the prior art in general teaches a motivation or suggestion to combine Want and Pulley to obtain the inventions of claims 1 and 9; and (c) Neither, Card, Beigel, or the prior art in general teaches a motivation or suggestion to combine Card and Beigel to obtain the invention of claim 1.

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37. As to point (a), it would have been obvious to a person of ordinary skill in the art that a first identification number can be an identifier. The question, then, is whether the person of ordinary skill in the art would have realized that the first identifier can be digitally readable (thus creating the digitally readable identifier of claim 9.) The '931 patent states that the first identification number is digitally readable (col. 3, lines 50 – 53, "*The method comprises the steps of manipulating one or more tags ...to provide a first senseme input (that includes the tag identification number) to the computer...*") Thus it would have been obvious to one of ordinary skill in the art that the first identification number of the '931 patent is indeed a digitally readable identifier as specified in claim 9.

38. As to point (b) the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Want and Pulley teach a motivation or suggestion to combine the two references to create the inventions of claims 1 and 9. Specifically, Want discloses various advantages of the tag and tag reader (Want, col. 1, lines 54 – 57, 61 – 65), as well as disclosing its uses as an input device (Want, col. 3, lines 48 - 59.) Pulley teaches that its invention requires an input device to allow the user to interact with the graphical environment (Pulley, col. 6, lines 1 – 3.) A person of ordinary skill in the art, seeing the advantages Want's invention provides with respect to input devices, would have been motivated to combine it and

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Pulley's graphical navigation system to create an intuitive and flexible method for navigating a flexible N-space.

39. As to point (c), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, a person of ordinary skill in the art would have realized that the tag and reader of Beigel would provide advantages similar to those provided by Want. Similarly, the person of ordinary skill in the art would have realized that the invention of Card requires an input device to operate (Card, Figure 1, reference characters 104 and 106, disclosing a keyboard and a cursor control device.) Thus a person of ordinary skill in the art, seeing the advantages Beigel's invention provides with respect to input devices, would have been motivated to combine it and Card's graphical navigation system to create an intuitive and flexible method for navigating a document data set.

Conclusion

40. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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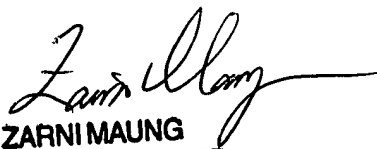
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

41. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Clinton whose telephone number is 703-305-3179. The examiner can normally be reached on Monday - Thursday 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on 703-305-9678. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Gregory Clinton
May 17, 2002


ZARNI MAUNG
PRIMARY EXAMINER